



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address : COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
---------------	-------------	----------------------	---------------------

08/035,601 03/23/93 KAPLAN

EXAMINER

23M1/0217

MICHAEL E. DERGOSITS
DERGOSITS & NOAH
FOUR EMBARCADERO CENTER, SUITE 510
SAN FRANCISCO, CA 94111

ART UNIT PAPER NUMBER

15

DATE MAILED:

02/17/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 12-6-93 And 12-13-93 And 1-3-94 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 90 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 14-24, 26-29, 33-34, 38-39, 66-76, 78-81, 85-86 And 90-91 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☒ Claims 1-13, 25, 30-32, 35-37, 40-65, 77, 82-84, 87-89 And 92-117 have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 14-24, 26-29, 33-34, 38-39, 66-76, 78-81, 85-86 And 90-91 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).

12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Art Unit: 2311

1. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification as originally filed does not provide support for the invention as is now claimed as set forth in the Office action mailed 2/17/94.

With respect to support for claiming that the user "maintains control" during the playback of a selection, applicant points to instant fig. 3 and describes a method of operating the system that makes use of this figure. However, this described method of operation is not specifically included in the instant specification. While the system may have the hardware to be capable of performing in the manner asserted, this method is not *inherent or required* by the system. The mere fact that fig. 3 shows a variety of selections from one album does not indicate whether the system is operable to cut the playback of one selection in the middle and jump to another selection. Applicant points to other sections of the specification for support, but they are equally inconclusive. With respect to the statement

Art Unit: 2311

relied on by applicant at the bottom of col. 2 of the issued patent regarding sampling individual selections as discrete increments, this refers to the manner in which these selections are culled, compressed and stored for playback on the storage medium in the kiosk because the kiosk does not contain entire songs but merely selected snippets or "discrete increments" from each of the selections. Further, concerning the statement relied on by applicant at col. 3 of the patent that the user makes a selection by touching the name of the song on the screen, this provides no indication of what happens when the screen is touched again, whether the user also has to wait for the selection to be played or an immediate jump to another selection is made. Thus, no part of the disclosure as originally filed provides support for reciting that the user maintains control during the time that a selection is being played back, nor could the specification being so amended without introducing new matter.

2. Claims 14-24, 26-29, 33-34, 38-39, 66-76, 78-81, 85-86, 90-91 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Art Unit: 2311

3. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

4. Claims 14-17, 22-23, 26, 33, 38, 66-69, 74-75, 78, 85 and 90-91 are rejected under 35 U.S.C. § 103 as being unpatentable over Stern et al. as set forth in the Office action mailed 2/17/94.

Firstly, the Schwede declaration has not been found to be persuasive. Throughout the Schwede declaration, reference is made to the "i station", and conclusions are drawn relative to the obviousness of deriving the "i station" from the teachings of Stern. However, this provides no proof relative to the *claimed* invention. The declaration provides no indication of what claim language provides any of the discerned differences or advantages

Art Unit: 2311

asserted therein. Moreover, the test of obviousness does not require that the entire invention, the "i station" be derived from the prior art since it is the claims, not the disclosure or invention itself, that are rejected under this grounds.

With respect to point 1) of the Schwede declaration, the appropriateness and flexibility of the user interface, it is asserted that the interface of Stern is ergonomically poor and does not allow a dynamically reconfigurable input selector that can be kept to a few easy choices. However, it is not seen where the claims are so limited. Likewise, the discussion of the inclusion of a bar code reader and a simulated keyboard that allow a variety of classifications for the user to jump among is a discussion of the alleged merits of the "i station" and not the broad language of the claims. While search mechanisms allowed under the particular user interface of the "i station" are stated as "crucial and powerful", they are not specifically claimed nor are they required to be able to be derived from the teachings of Stern.

Concerning point 2), the content of the stored material and its relation to the product being sold, the Schwede declaration asserts that "music videos are a separate art form and product which product is not contained on the CD's" that the user is previewing. However, this ignores the fact that music videos are commonly produced with at least the same music track that appears

Art Unit: 2311

on the CD that the system user would be buying. Thus, watching and listening to the music video does provide a preview of the product that is being considered for purchase. While a music video also provides additional information, this does not alter the existence of the music. Asserting that a music video does not allow a user to audition the material that is to be purchased is like saying that seeing a live concert does not provide an indication of the content of a performer's CD because of the extra visual information. Such concerts are well known promotions of CD sales. Moreover, the "i station" does not provide pure audio preview either. As set forth in col. 6, lines 2-3 of the Kaplan patent, "additional options include full motion MTV videos or record reviews". Thus, the "i station", and the claims, are not limited to only previewing the actual program material on the product which the user is making a buying decision as asserted in the Schwede declaration.

With regards to point 3), data collection features of the system, this analysis is again directed at the "i stations" and not the claimed invention. The instant claims do not call for data gathering or the communication of data among several "i stations".

In summary, the Schwede declaration has not been found to be persuasive in that it concerns itself with the system as disclosed or currently implemented and not with the invention as

Art Unit: 2311

broadly recited in the claims. Finally, the Schwede declaration attempts to generate a distinction with respect to information content, but fails to consider the entire content of information provided by the "i station" and common practices in the art.

With respect to applicant's remarks concerning Stern, applicant asserts that the identification of a product for preview in the instant claims is a two step process wherein the product itself is identified and then the selection is identified. Initially, note that the claims do not specifically set forth the timing of the steps of selection nor is the asserted second step specifically recited as being performed in response to the selection made in the first step. See claim 22 for example. Since the selection means of Stern must inherently identify both the product and a selection therefrom since it plays one selection from the album, it is seen to read on the broadly recited selection. Applicant further argues that Stern does not provide the user with any other choices concerning the identified album, yet this has been found as an obvious modification of Stern as outlined in the previous Office action regarding multiple singles from the same album. In any event, even if it were narrowly recited in the claims, such a two step process for reproducing a particular musical selections is old in the art considering the known playback machines and the manual steps necessary to achieve such reproduction. In order to

Art Unit: 2311

reproduce a particular song on a CD player, phonograph or tape deck, it is well known that one must first select the medium that the song is provided on, then select or index to the location of the desired song among the songs on the medium. Note also that the background of the invention of Stern teaches a computer touch screen that uses menus and multi-step accessing in previewing music.

With respect to the controlled playback feature, support for this in the specification as originally filed has not been found. For the sake of argument, applicant's comments regarding the 35 USC 112, first paragraph, rejection indicate that because multiple selections are presented to the user at one time for the user to select from, support is provided for "maintaining control" during playback. If the mere existence of multiple selections at one time is proof that the user maintains control during playback, then Stern must also include the maintaining of control during playback due to the presentation of multiple choices to the user.

Also, applicant comments that it would not be apparent, nor suggested by Stern, how to modify the system to provide user interaction as recited. Initially, note that the broad recitation of maintaining control throughout the duration of selection playback would be met by merely allowing one of a stopping, pausing or skipping function during playback.

Art Unit: 2311

Furthermore, the specific teachings of Stern are not the limits of what those of ordinary skill in the art would appreciate. As is notoriously well known in the art, conventional CD and laser disk players already include stop, pause and skip controls that are active during playback and provide the obvious advantage of allowing timely access and control over the reproduction of the medium. Stern has not invented a new laser disk player for his apparatus, but uses conventional RCA or Sony players in a preferred embodiment. Moreover, as mentioned previously, Stern provides no indication that these controls are locked out during playback, and provides a return in the playback loop in the flow chart of fig. 11 that allows further selection while still in play mode. Note step 138, "still in play mode?" which leads back to the "read keyboard" step 102 after either a "yes" or "no" response. Thus, even if fig. 11 of Stern somehow does not provide user control during playback, considering the knowledge commonly available to those of ordinary skill in the art in addition to the teachings of Stern, motivation is provided to incorporate the known disk player controls in the system of Stern for their known advantages. In other words, merely adding, for example, a stop button to stop playback would have been obvious to those of ordinary skill in the art and would meet the recited control.

Art Unit: 2311

5. Claims 18-21, 27-29, 70-73 and 79-81 are rejected under 35 U.S.C. § 103 as being unpatentable over Stern et al. as applied to claims 14-17, 22-23, 26, 33, 38, 66-69, 74-75, 78, 85 and 90-91 above, and further in view of Hughes.

Initially, applicant incorporates herein the Schwede declaration and the arguments presented with respect to Stern alone, which have been treated above. Applicant then appears to assert that Hughes represents non-analogous art. However, while analogous art includes art in the same field of endeavor, it also encompasses art in related fields where a similar problem is addressed. In Hughes, while production of an audio tape is the end product, the system of Hughes can also be used for reproduction alone. Clearly, it is up to the user's intentions, not any structural difference, as to whether this reproduction without recording is a "preview" or merely for enjoyment. Further, the fact that Hughes includes means for monetary input does not alter the teachings regarding the tracking of songs played. Thus, it is not seen how Hughes can be considered non-analogous. Concerning applicant's assertion that Hughes is so different from Stern that no motivation would be found to combine them, note the motivation set forth in the previous action. While royalty data is useful for paying the proper fees, it would have been readily recognized by those in the art as also providing an indication of the popularity of particular songs

Art Unit: 2311

since royalty payments are directly equivalent to sales. As is well known in the art, effective management of such systems relies on having products available that consumers are interested in and popularity data provides indications of trends or interests that must be responded to. Note that those in the art are presumed to know something more about the art than only what is disclosed in the applied references and that the knowledge of those in the art is relied on by every reference to complement that which is disclosed therein. Thus, it would have been obvious to those of ordinary skill in the art to modify the system of Stern to include the collection of frequency data so as to effectively manage the system.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Serial Number: 08/035,661

-12-

Art Unit: 2311

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Weinhardt whose telephone number is (703) 305-9780.

Facsimile transmissions may be directed to (703) 305-9564 or 9565.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3800.

April 20, 1994



ROBERT A. WEINHARDT
PRIMARY EXAMINER
GROUP 2300